

EXPRESS MAIL NO. EV 320 858 224 US

DATE OF MAILING 7/21/03

Our File No. 60021010-0003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Nancy Allbritton, et al.

Serial No. 09/990,413

Filing Date: November 21, 2001

For Method to Measure the Activation
State of Signaling Pathways in Cells

Examiner D. Cheyene Ly

Group Art Unit No. 1631

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RESTRICTION RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Official Action of May 21, 2003 Applicants elect, with traverse,
Group III, Claims 10-22 and 24-45.

Furthermore, Applicants elect the following species:

Species A: electrophoresis;

Species B: 2-D gel electrophoresis;

Species C: microinjection;

Species D: a microlumen;

Species E: a microlumen;

Species F: a laser

RESTRICTION RESPONSE

The Office has restricted the present application as follows:

Group I -- Claims 1-4 drawn to an improvement in a method for assessing protein
activity;

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Group II -- Claims 5-9, drawn to a method for profiling signal transduction pathways;

Group III -- Claims 10-22 and 24-45, drawn to a method of detecting protein activating;

Group IV -- Claims 23 drawn to an improvement in a method for detecting protein activity and

Group V -- Claims 46-65, drawn to an apparatus for measuring the protein activity in a cell.

Applicants elect, with traverse, Group III, Claims 10-22 and 24-45.

Furthermore, Applicants elect the following species:

Species A: electrophoresis;

Species B: 2-D gel electrophoresis;

Species C: microinjection;

Species D: a microlumen;

Species E: a microlumen;

Species F: a laser

Applicants would like to thank Examiner Ly for the courteous and helpful discussion held with Applicants' representative on July 21, 2003. During this discussion the Examiner helped clarify the species election and noted that that were two claims number 40, and therefore the second of these and all subsequent claims have been renumbered.

Restriction is only proper if the identified groups are independent or distinct. The burden is on the Office to provide reasons and/or examples to support its conclusion that the identified groups are independent or distinct. M.P.E.P § 803.

The Office has characterized the relationship between Groups I-V as product and process of use. Citing M.P.E.P. § 806.05(h) the Office states that the apparatus of Group V may be utilized in the distinct usages as noted in Group I which is an improvement in a method for assessing protein activity in a cell; as needed in Group II, which is a method for profiling signal transduction pathways; as needed in Group III which is a method of detecting protein activity in a cell, portion of a cell, or a group of cells; and as needing Group IV which is an improvement in a method for detecting protein activity in a cell portion, portion of a cell or group of cells. Alternatively, the

Office states that the apparatus could be used to analyze the differential expression of a gene as it is related to a lung cancer. The Office then goes on to state that these usages are distinct as requiring distinct and different functions and results, and thereof without overlapping search due to different subject matter.

Applicants note that the Office has failed to characterize the relationship between Groups I, II, III and IV, all of which are methods. Furthermore, the Office has failed to provide any reasons or explanation about why these groups are distinct from each other. Accordingly, Applicants submit that the Office has failed to meet its burden to sustain a restriction between these four Groups.

Furthermore, the basis of the restriction between Group V and the remaining Groups is that the apparatus of Group V may be utilized in materially different processes, set forth in Group I-IV. However, the basis of this restriction relies in part on the conclusion that Groups I-IV are materially distinct from one another. Since the Office has failed to provide any explanation whatsoever as to why these groups are materially different, the Office has not met its burden in order to sustain the restriction between Group V and the remaining Groups.

Applicants respectfully submit that the Office has failed to meet the burden needed in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants submit the application is now ready for examination on the merits. Early notice of such action is earnestly solicited.

Respectfully submitted,



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